REMARKS

This amendment is presented in response to the office action mailed May 4, 2005. In this paper, claims 32-33, 35-37, 40-41, 43, 46, 53-54, 56-62 were amended, claims 38-39, 42 canceled, and new claims 63-65 added. Presently,
5   the application contains claims 1-37, 40-41, 43-65. Applicant requests favorable reconsideration and allowance of all claims in the application.

35 USC 102 REJECTIONS: CLAIMS
1, 12, 14, 15, 17, 27, 31-35, 37, 39, 42, 58, 60

10   These claims were rejected under 35 USC 102(e) as being unpatentable over U.S. Patent No. 6,567,072 B2 to Watanabe. Applicant traverses this rejection because the applied art does not teach the features of the claims, as required.

Taking claim 1 as an example, Watanabe fails to teach the following
15 combination:

"A text entry input system, comprising:
a directional selection means, plus one or more buttons or equivalent user input means;
20   a collection of linguistic objects;
an output device with a text display area; and
a processor which comprises an object search engine, a distance value calculation module, a linguistic object module for evaluating and ordering linguistic objects, and a selection component;
25   wherein said directional selection means is used to point in a direction of each of the letters, or the letters' sub-word equivalents in each writing system, of a linguistic object, said processor calculating a distance to find letters and weight values for the letters in said pointing direction with said distance calculation module, said processor retrieving a
30   predicted list of linguistic objects based on the letters and weight values with said object search engine, said processor evaluating and ordering said predicted list of linguistic objects with said linguistic object module, and said selection component being used to select a desired linguistic object from said predicted list of linguistic objects."
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The examiner bears the burden of establishing a *prima facie* case of anticipation.[1] The prior art reference must disclose each element of the claimed invention, as correctly interpreted, and as arranged in the claim.[2] A claim is anticipated only if each and every element as set forth in the claim is found,
5 either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the claim.[3]

Considering claim 1 in greater detail, Watanabe fails to disclose the claimed combination including a processor which includes an "object search
10 engine... said processor retrieving a predicted list of linguistic objects based on the letters and weight values with said object search engine." In contrast, Watanabe has no need to predict any list of linguistic objects because Watanabe's user selects the exact character desired through intricate manipulation of the circumferential position and radial position/load of a joystick
15 along with key entry. [Watanabe: col. 9, lines 29-35, 41-47.] Therefore, Watanabe does not show a predicted list of linguistic objects, as claimed. In Watanabe, circumferential and radial joystick positions correspond to row and column of a currently selected symbol table, e.g., Hiragana, Arabic, Katakana, etc. [Watanabe: FIGS. 5a-5c] A further example is discussed at Watanabe's
20 col. 9, lines 18-48, and FIG. 8a. The claimed "object search engine" avoids the unduly complicated approach of Watanabe by avoiding the necessity of achieving precise joystick tilt in order to enter characters.

The office action suggests that the claimed feature is taught by Watanabe's col. 9, line 1-17 and FIG. 7. However, a careful reading of
25 Watanabe reveals this as being false, and additionally underscores Watanabe's failure to teach the claimed feature. In particular, the cited passage discusses

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[1]   In re King, 801 F.2d 1324, 1327, 231 USPQ 136, 138-139 (Fed. Cir. 1986).

[2]   Lindermann Maschinefabrik Gmbh v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984).

[3]   MPEP 2131.

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certain details of the mapping between cursor manipulation and character
selection. For example, Watanabe is said to use five concentric circles each
divided into 12 sectors of 30 degrees each, and at the intersection of the radially
extended sector lines and each concentric circle, when the Hiragana character

5   set is selected, the rows "a through wa" are mapped clockwise, and in the case
of the row "a", "a through u" are mapped at the intersection of a radially extending
line and each concentric circle. [Watanabe: col. 9, lines 9-17] Consequently,
Watanabe does not teach the claimed combination including a processor which
includes an "object search engine... said processor retrieving a predicted list of

10   linguistic objects based on the letters and weight values with said object search
engine."

        Watanabe further lacks the claimed processor, which comprises a
"linguistic object module for evaluating and ordering linguistic objects...said
processor evaluating and ordering said predicted list of linguistic objects with said

15   linguistic object module." Lacking the claimed "predicted list of linguistic objects"
(as discussed above), Watanabe necessarily lacks the claimed processor
"evaluating and ordering said predicted list of linguistic objects with said linguistic
object module" as claimed. Furthermore, Watanabe lacks any operation to
evaluate and order linguistic objects. Since Watanabe's user directly enters the

20   desired character with radial and circumferential inputs, Watanabe has no need
to evaluate and order a predicted list of linguistic objects.

        The office action suggests that such features are found in Watanabe's col.
8, lines 51-67 and FIG. 6. Upon careful reading, however, the cited passage
merely discusses displaying an icon the upper right corner to indicate which

25   character set has been selected. There is no discussion of anything related to a
"linguistic object module for evaluating and ordering linguistic objects...said
processor evaluating and ordering said predicted list of linguistic objects with said
linguistic object module" as claimed.

        Watanabe further lacks the claimed processor, which comprises a

30   "selection component" with "said selection component being used to select a
desired linguistic object from said predicted list of linguistic objects." Watanabe

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lacks any predict list of linguistic objects, as discussed above. Namely, Watanabe does not disclose any predicted list of linguistic objects because Watanabe's user unambiguously selects the desired character with circumferential and axial joystick movements along with key confirmation.

5   Hence, Watanabe also lacks the claimed selection component to select a linguistic object from such a list.

The office action suggested that this feature is disclosed by Watanabe's determination key 4, and particularly in col. 9, lines 18-47 and FIGS. 8a, 8b, 11. A more careful reading of the reference shows that this is false. In Watanabe,

10   the 'I" is selected, and at this point the determination key is pressed, and "I" is simply selected." [Watanabe: col. 9, lines 46-48] The selected character is made the input character when there is input to the effect that one among the displayed characters has been selected as an input character from the key input means. [Watanabe: col. 4, lines 10-15] There is no showing in Watanabe of the

15   determination key "being used to select a desired linguistic object from said predicted list of linguistic objects" as claimed.

Accordingly, independent claim 1 is patentably distinguished from Watanabe. For similar reasons, independent claim 32 (as amended) is also patentably distinguished from Watanabe. And, even without considering any

20   individual merits of dependent claims 2-31, 33-37, 40-41, 43-62, these claims are distinguished from Watanabe because they depend from patentably distinguished independent claims 1 or 32.[4]

35 USC 103 REJECTIONS: CLAIMS
25   2-11, 13, 16, 18-26, 28-30, 36, 38, 40-41, 43-57, 59, 61-62

These claims were rejected under 35 USC 103 as being unpatentable over one or more of the following: (1) Watanabe alone, (2) Watanabe in various combinations with other references. Even without considering the individual

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[4]   Cf. If an independent claim is nonobvious under 35 USC 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). MPEP 2143.03.

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merits of these claims, they are patentably distinguished over the proposed combinations or modification involving Watanabe. Namely, the subject claims depend from independent claims that are already allowable over Watanabe (as discussed above), and the added references or suggested modifications still fail

5 to provide the features that are still missing from Watanabe.[5]

Furthermore, as to the suggested combination of Watanabe with U.S. 5,748,512 to Vargas in rejection of claims 19-23, 40-41, 46-53, this rejection is improper because a *prima facie* case of obviousness does not exist, as discussed in greater detail below.[6]

10 First, the *prima facie* obviousness case is incomplete because, even if the references were to be combined as suggested (albeit improperly, as discussed below), the combination still does not teach or suggest all the claim limitations.[7] Various features of the independent claims are missing from Watanabe as mentioned above, and Vargas still fails to provide them. For instance, Vargas

15 still does not teach "a processor which comprises an object search engine, a distance value calculation module, a linguistic object module for evaluating and ordering linguistic objects, and a selection component" as claimed. Instead, Vargas was introduced in an attempt to supply specific linguistic features, and more particularly, details concerning a linguistic model. [Office Action: pages 12-

20 13]

In addition to the reasons given above, the *prima facie* obviousness case as to claims 19-23, 40-41, 46-53 is also defective because there has been no suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the

25 reference or to combine reference teachings.[8] The office action suggests that it

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[5] If an independent claim is nonobvious under 35 USC 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). MPEP 2143.03.

[6] MPEP 2142.

[7] MPEP 2142, 2143.03.

[8] MPEP 2142.

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would have been obvious to one of ordinary skill in the art at the time of the invention "to combine the predicted linguistic objects as taught by Vargas with the text input method taught by Watanabe so that a likely correct entry is entered even when the user touches a key off center." [Office Action: page 13] On the

5 contrary, the suggestion or motivation to make the proposed modification is lacking since Watanabe teaches away from such a combination. In particular, Watanabe purportedly shows an approach that involves moving a joystick in circumferential and axial directions to select a character and confirming with another key. For example, the "I" is selected, and at this point the determination

10 key is pressed, and "I" is simply selected. [Watanabe: col. 9, lines 46-48] The selected character is made the input character when there is input to the effect that one among the displayed characters has been selected as an input character from the key input means. [Watanabe: col. 4, lines 10-15] "The selected character is made the input character depending on the circumferential

15 position information when there is input to the effect that one among the displayed characters has been selected as an input character from the key input means." [Watanabe: col. 18, lines 30-35] See also, col. 7, line 61 - col. 8, line 5. This approach guarantees accuracy, because the user would not touch the determination or other such confirmation key unless the joystick positioning was

20 accurate.

Furthermore, Watanabe already provides a character editing operation which would be satisfactory to rectify a situation where the user touches a key off center, without requiring any teachings from Vargas. [Watanabe: Fig. 18] Therefore, the only reason to combine Watanabe and Vargas is hindsight

25 reconstruction, in an improper attempt to arrive at the claimed structure. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.[9] Furthermore, it is improper to combine references where the references teach away from their

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[9] *W.L. Gore & Associates, Inc.* v. *Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). MPEP 2141.02

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combination.[10] Accordingly, the claims are patentable because the required suggestion or motivation to combine references is lacking.

In addition to the reasons stated above, the *prima facie* obviousness case is further defective because the office action failed to show that there would be a

5   reasonable expectation of success in modifying/combining references.[11] The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.[12] If the examiner does not produce a prima facie case, the applicant is under *no* obligation to submit evidence of nonobviousness.[13] Critically, to establish a *prima facie* case of obviousness,

10   there <u>must</u> be a reasonable expectation of success.[14] This reasonable expectation of success must be found in the prior art, not in Applicant's disclosure.[15]

The office action lacks any evidence, allegation, or other mention of the legally required "reasonable expectation of success" in combining the teachings

15   of Watanabe and Vargas. Since this mandatory topic is unaddressed by the office action, no *prima facie* case of obviousness has been properly established.

Furthermore, since Watanabe and Vargas utilize completely inconsistent approaches, an ordinarily skilled artisan would <u>not</u> enjoy reasonable prospects of success in combining the Watanabe and Vargas. As mentioned previously,

20   Watanabe utilizes a key/joystick character entry procedure requiring confirmation by a user, whereas utilizes Vargas simple keyboard entry. Accordingly, this fundamental difference suggests that there is a poor expectation of success to be realized by combining the references.

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10   *In re Graselli*, 713 F.2d 731, 218 USPQ 769, 779 (Fed. Cir. 1983). MPEP 2145(4).

11   MPEP 2142, 2143.02.

12   MPEP 2142.

13   *Id.*

14   MPEP 2143.

15   *In re Vaeck*, 947 F.2d 488, 20 USPQ.2d 1438 (Fed. Cir. 1991). MPEP 2143.

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NEW CLAIM

New claims 63-65 have been added to the application. These claims are patentable over the applied art for similar reasons as discussed above. No new matter has been added, since the new claims enjoy ample support throughout

5   the originally-filed specification, e.g. page 5, line 15 to page 18, line 10, and Figures 1-3, 4b, 5.

CONCLUSION

In view of the foregoing, all pending claims in the application are

10   patentable over the applied art. Favorable reconsideration and allowance of the application are hereby requested.

The Commissioner is authorized to charge the fee of $600.00 for the three extra independent claims and any additional fees that may be due or credit any overpayment to Deposit Account No. 07-1445.

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